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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,392	04/19/2004	Jonah Staw	89235	3113
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COLLEN IP THE HOLYOKE MANHATTAN BUILDING 80 SOUTH HIGHLAND AVENUE OSSINING, NY 10562			EXAMINER ZURITA, JAMES H	
			ART UNIT 3625	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/827,392

**Applicant(s)**

STAW ET AL.

**Examiner**

James H. Zurita

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date 20071016.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

Applicant's response of 13 June 2007 has been entered.

Claims 1-23 are pending, claims 1-20 are being examined.

### *Response to Arguments*

Applicant's arguments with respect to claims 1-20 have been considered.

Applicant argues

The terms "coordinating" and "non-matched" are disclosed in the specification including **examples** and figures in such a way as to enable their use in the claims.

"In addition, this invention packages and distributes the coordinated but non-matching items in non-traditional quantities (e.g. 3, 5, 7 socks)."

Table 1 is a list of **example** items traditionally sold in pairs. Figure 1 illustrates **example** grouping for 3 coordinated but non-matching socks. The second paragraph in the Detailed Description of Preferred Embodiment starting on page 4, discloses the category of items which are traditionally sold in pairs.

The third sentence of this paragraph states: "It is envisioned that items in the category will be sold in single packages of both traditional and non-traditional (e.g. 3, 5, 7) quantities."

... kitchen accessories, not a kitchen. In addition, Claim 16 is dependent on Claim 15 which claims the product is "chosen from a category of products traditionally matched within a group." This Claim 16 is claiming kitchen accessories traditionally matched.

... the specification including the **example** and figure defines and fully enables method for creating coordinates and matching products.

Respectfully, examples are not definitions. During prosecution, terms are given their broadest reasonable interpretation. See rejections under 35 USC 112.

### ***Claim Objections***

The claims are generally narrative and indefinite, failing to conform to current U.S. practice. The claims are replete with grammatical and idiomatic errors. Some example follow.

Claim 1 refers to "...*the system for coordinated non-matching* [missing noun, product?]. Claim 1 also refers to "...creating a [*singular*] systems [*plural*] to be used to coordinate the non-matching [what? noun is missing]... a system [no label] ...and applying *the system* [no label]. Dependent claims that refer to *system therefore* lack proper antecedent basis, since it is not clear which system of claim 1 is addressed.

Claims 2 and 3 refer to "...*the system for coordinated non-matching [product?]* and lack proper antecedent basis, since Claim 1 refers to "...creating a [*singular*] systems [*plural*] to be used to coordinate the non-matching [what? noun is missing]... a system [no label] ...and applying *the system* [no label].

Claims 4, 13, 19 and 20 lack antecedent basis, since Claim 1 refers to "...selecting *the product*..." while the claims read:

Claim 4 "...products [plural] selected are...",  
Claim 13 "...products [plural] is [singular verb] a [...] set [plural]...",  
Claims 19 and 20 "...product selected are chosen [plural]..."

Claim 4 refers to "...products traditionally sold in pairs..." claim 5 refers to "...product is packaged for sale in non-traditional quantities..." which appears to contradict the limitation of claim 4.

Claim 6 refers to "...the product is [singular noun and verb] socks [plural]..." For purposes of proper syntax and proper antecedent basis, claim 6 is interpreted to read

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"...the product is [a pair] of socks" and claim 7 is interpreted to read "...the product is [a pair of] earrings".

Claim 1 refers to distinguishable components (not used in specifications). Claim 8 refers to distinguishable parts and claim 11 refers to multiple pieces. The nouns components, parts and pieces are plural. The use of the plural appears to require that the products have more than one identifiable component/part/piece. See also rejection under 35 USC 112, second paragraph.

Please review materials for similar errors. See MPEP 608.01(m).

Correction is required.

### ***Claim Rejections - 35 USC § 101***

Claims 1-20 are rejected under 35 U.S.C. 101 because the claim is directed to different statutory classes.

Claim 1 is drawn to different statutory classes. The preamble refers to a method for creating...products, [a process claim] while one of the limitations refers to creating a system [an apparatus claim]. MPEP 2173.05(p). The term **system** is interpreted as referring to a series of steps rather than to an apparatus.

Prior Art will be interpreted to read on Claims 1-20 where Prior Art discloses structural components that are reasonable capable of performing applicant's intended functions. The Examiner notes that nothing in applicant's structure distinguishes the instant invention from the structure of the reference.

***Claim Rejections - 35 USC § 112***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Creating

In claim 1, creating and creation render claim 1 indefinite, since it is not clear how and what is created. The preamble merely recites purposes of the process. The body of claim 1 recites creating a system (process steps) that is then used to create a product: Since claim 1 is indefinite, claims 2-20 are also indefinite.

..." creating a systems [plural] to be used to coordinate [verb] the non-matching [what? a single product? Noun is absent]

"...applying the system to the product's creation..." the product has no label.

In claim 1, the step of selecting the product appears to refer to the product in the preamble. However, the limitation applying the system to the product's creation does not make sense, since the product already exists and has already been selected.

In Claim 1, the term coordinate (and its derivatives) appears in the preamble and in the body of the claim in different forms (an adjective, an adverb and as a verb):

1. A method for creating [non-matched but **coordinated**] products comprising:
  - Selecting the product to be [**coordinated** but not matched] wherein the product has distinguishable components;
  - Selecting a feature on the product for [**coordinating** but not matching] [noun missing];
  - Creating a systems to be used to **coordinate** the non-matching [products??];

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- Applying the system to the product's creation.

In the preamble of claim 1, the terms carry given little to no patentable weight because it carries no active part of the claim, since the language describes actions that take place in steps that are not active parts in claim 1.

In the steps of claim 1, the language is given little to no patentable weight because carries no active part of the claim, since the language describes actions that take place in steps that are not active parts in claim 1. As such, the descriptive material imparts little patentable moment in distinguishing the method of claim 1 and its dependent claims from the prior art.

#### Coordinated, not-matched and their derivatives

In claim 1, the terms Coordinated, not-matched [and their derivatives] appear to be descriptive material that come to life only with claim 2 (coordinated) and claim 3 (matching and non-matching). The combinations of the terms merely describe inferential activities that, in claim 1, are not involved in an active sense and are not positively recited.

Applicant's specifications do little to clarify. For example:

- coordination means directed towards target consumer group, such as children.
- Although the colors, shapes, patterns and other coordination means may change, the same principles included in the basic principles of defined coordination would be applied.
- This invention also includes almost numberless coordinated patterns based on seasons, function, activities, culture, etc. Example seasonal patterns include...
- This invention envisions products in all the identified categories (FIGS. 1-5). Table 6 lists sample characteristics for achieving coordination for a product within each of the 5 categories defined by this invention.
- targets girls would be created based on the age, sex, culture, function, organization etc.

#### Match[...] non-match[...]

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- For purpose of this invention matching should be construed to mean the grouping of items in like colors and patterns or in predefined number of items per distributed package, such as socks that are sold in pairs to accommodate the 2 feet of the human body.

### Distinguishable

In claims 1, 8 and in claims dependent thereupon, the term distinguishable renders the claims indefinite. Claim 1 refers to distinguishable components (not used in specifications). Claim 8 refers to distinguishable parts and claim 11 refers to multiple pieces. The nouns components, parts and pieces are plural. The use of the plural appears to require that the products be identified as having more than one identifiable component/ part/ piece. See also claim objections.

### Components, parts and pieces.

Claims 1, 8 and 11 appear to claim patentable distinction by using the words components, parts and pieces. Yet, the specifications and drawings appear to use the terms as synonyms. The terms will be interpreted as synonyms.

In Claim 2, the term "...intended user..." renders the claim indefinite. The term non-matching carries little to no patentable weight since the limitation comes to life with claim 3. Further, In Claim 2, the term coordinating is indefinite. The claim is interpreted to include market segmentation, advertising based on demographic aspects of target groups (segments of population). Prior art is interpreted to meet the limitation where prior art discloses marketing, advertising and otherwise select users, such as by demographics, including age and gender.



In Claim 3, the term *coordinated* is indefinite. The disclosures refer to

The present invention relates to a unique system and method for

- manufacturing,
- packaging,
- marketing,
- distributing and
- selling

items which have traditionally been essentially matching. [Page 1, Field of Invention, emphasis and punctuation added].

This invention is a unique method to manufacture, package, market, distribute and sell [coordinated non-matching] items which have traditionally been matched. [Abstract]

- numberless coordinated patterns based on seasons, function, activities, culture, etc. Example seasonal patterns include: Winter: Snowflakes Spring: Bunnies (for Easter) Summer: Flowers Fall: Leaves
- TABLE 6 is Sample Coordinating Characteristics for...items. Color Shapes Theme characters/objects Seasons Holidays Activity

For purposes of examination, the claim is interpreted as referring to determining product characteristics according to selected target groups.

- numberless coordinated patterns based on seasons, function, activities, culture, etc. Example seasonal patterns include: Winter: Snowflakes Spring: Bunnies (for Easter) Summer: Flowers Fall: Leaves
- TABLE 6 is Sample Coordinating Characteristics for...items. Color Shapes Theme characters/objects Seasons Holidays Activity

#### Traditional and non-traditional

In claims 4, 5, 15, 18-20, the terms *traditional*, *non-traditional* quantities [and derivatives] are relative terms that render the claims indefinite. The terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear how one determines what is traditional and non-traditional in order to avoid infringement. In the absence of an explicit definition,

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the terms traditional, non-traditional [and derivatives] are given their broadest reasonable interpretation to include any aspect of cultural continuity in social attitudes, customs, and institutions. MERRIAM WEBSTER Collegiate Dictionary.

Prior art will be interpreted as reading on traditional, non-traditional **quantities** [and derivatives] where prior art discloses the action as occurring on any quantity of a product.

Claims 5, 14 and 18 refer to how the resultant product [singular] is packaged in quantities [plural].

Claim 5	product is packaged for sale in non- traditional quantities
Claim 14	product is packaged in non-traditional quantities.
Claim 18	product is packaged in non-traditional quantities

Claims 4, 15, 19 and 20 refer to ...product[s] selected is/are chosen from a category of products traditionally ..." and appear to apply tradition to (a) matching products, and (b) selling products:

Claim 15	products traditionally matched within a group
claims 4, 19, 20	products traditionally sold in pairs
Claim 19	wherein the products have multiple unconnected pieces.
Claim 20	wherein the products have multiple physically connected pieces.

There is brief mention of "...early humans..." and "...[some unidentified] color philosophy..." and "...every girl's favorite colors..." and "...nearly every girl's favorite..."

Applicant also refers to "...[products] which have traditionally been essentially matching..." emphasis added, with further obscures any distinction.

In Claim 8, "...products with distinguishable parts..." renders the claims indefinite as a relative term. If a product has parts [plural, more than one], at what level would the parts not be distinguishable (atomic level, eyesight, other) from other products and parts of the same product.

Claim 15 refers to "...products traditionally matched within a group..." and claim 16 refer to "...a product that is a kitchen accessories..." Table 5 provides samples of what applicant refers to as "...kitchen accessories..." that applicant feels are "...traditionally matched within a group..." Prior art is interpreted to meet the limitation where prior art discloses items that may be mixed and matched.

In claim 16, the term "...accessories..." is a relative term that renders the claim indefinite. Accessories are things that are secondary or subordinate importance. MERRIAM WEBSTER Collegiate Dictionary. Prior art will be interpreted to meet the limitations of the claims where prior art discloses the use of furniture, curtains, for example.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-6, 8-12, 14-16, 18-20, **as interpreted**, are rejected under 35 U.S.C. 102(b) as being anticipated by Feld et al., US PG-PUB 20010026272, filed 26 February 2001 and published 4 October 2001.

***As per claim 1***, Feld discloses methods for creating non-matched but coordinated products comprising:

Selecting the product to be coordinated but not matched wherein the product has distinguishable components (see, for example, at least paragraph 0054);

Selecting a feature on the product for coordinating but not matching [as interpreted]. see paragraph 0045;

Creating a system to be used to coordinate the non-matching. See, for example at least Figs. 5, 6 and 10 for series of steps in the system;

Applying the system to the product's creation (paragraph 0012).

**As per claim 2**, Feld discloses that system for coordinated non-matching considers age (paragraph 0035) sex (paragraph 0032) and culture, of the intended users for the product.

**As per claim 3**, Feld discloses considering the characteristics of color (paragraph 0039), patterns (paragraph 0013), shapes (paragraph 0002) and size (paragraph 0039) for coordination.

**As per claim 4**, Feld discloses that products selected are chosen from a category of products traditionally sold in pairs (socks, as in paragraph 0032).

**As per claim 5**, Feld discloses that a product is packaged for sale in non-traditional quantities. See paragraph 0002.

IN claim 5, non-traditional quantities is interpreted as

**As per claim 6**, Feld discloses that products are product is socks (paragraph 0032).

Claim 7 is rejected under 35 USC 103, below.

**As per claim 8**, Feld discloses that product selected is chosen from a category of products with distinguishable parts (eyeglasses, as in paragraph 0032); see also Fig. 11.

**As per claim 9**, Feld discloses that product is a pair of eyeglasses (paragraph 0032).

**As per claim 10**, Feld discloses that product is a pair of sweatpants. See Jumpsuits, as in Paragraph 0032.

**As per claim 11**, Feld discloses that product selected is chosen from a category of products with multiple pieces. See for example, at least Fig. 11 and related text.

**As per claim 12**, Feld discloses that the product is pajama tops, bottoms, and slippers. Paragraph 0032, lingerie, underclothing.

Claim 13 is rejected under 35 USC 103, below.

**Claim 14** is rejected on the same grounds as claim 5.

**As per claim 15**, Feld discloses that that the product selected is chosen from a category of products traditionally matched within a group. See at least Fig. 11 and related text. See also paragraph 0054

**As per claim 16**, Feld discloses that that the product is a kitchen accessory. See at least paragraphs 0008, 0032 and other references to furniture coverings, curtains, etc.

Claim 17 is rejected under 35 USC 103, below.

**Claim 18** is rejected on the same grounds as claim 5.

**As per claim 19**, Feld discloses that that the product selected are chosen from a category of products traditionally sold in pairs wherein the products have multiple unconnected pieces. See references to suits, as in paragraph 0032.

**As per claim 20**, Feld discloses that the product selected are chosen from a category of products traditionally sold in pairs, wherein the products have multiple physically connected pieces. See, for example, at least Fig. 11 and related text.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 7, as interpreted, is rejected under 35 U.S.C. 103(a) as being unpatentable over Feld.**

**As per claim 7**, Feld discloses jewelry (paragraph 0032). Feld **does not** specifically refer to earrings. It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Feld to include earrings. One of ordinary skill in the art at the time the invention was made to extend Feld to include earrings for the obvious reason that earrings are used to complete a personal image.

**Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feld in view of Berger, US 6,414,693.**

**As per claim 13**, Feld does not specifically disclose a luggage set. This is disclosed by Berger, Col. 1, lines 12-33. It would have been obvious to one of ordinary

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skill in the art at the time the invention was made to combine Feld and Berger to disclose that a product is a luggage set.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Feld and Berger to disclose that a product is a luggage set for the obvious reason that a customer can thereby customize appearances of base articles.

**Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feld in view of Marx et al. (PG-PUB 2003/0104148A1).**

***As per claim 17***, Feld ***does not*** specifically disclose that products include clothing for members of a team. This is disclosed by Marx, paragraph 0008. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Feld and Marx to disclose that products are clothing for team members. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Feld and Marx to disclose that products are clothing for team members for the obvious reason that fans may wish to match their favorite college and professional team colors and designs.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Zurita  
Primary Examiner  
Art Unit 3625  
30 November 2007



JAMES ZURITA  
PRIMARY EXAMINER